

Amendment and Response

Applicant: Mark Haines et al.

Serial No.: 10/635,409

Filed: August 6, 2003

Docket No.: 200210234-1

Title: FILTER FOR PRINTHEAD ASSEMBLY

REMARKS

Claims 25-27, 29-35, and 37-40 are withdrawn.

Claims 1-3, and 5-12 are pending.

Response to Restriction under 35 U.S.C. § 121

The Office Action placed yet another set of restrictions on the pending claims; now alleging that Claims 1-3 and 5-12 are drawn to an "Invention IA", Claims 25-27 and 29-32 are drawn to an "Invention IB" and Claims 33-35 and 37-40 are drawn to an "Invention IC".

Applicants hereby elect the Invention IA as defined in the Office Action, but with traverse. Accordingly, Claims 25-27, 29-32, 33-35, and 37-40 have been withdrawn.

Applicants traverse these additional restrictions for at least the reasons stated below. It is respectfully requested that the restriction be reconsidered and withdrawn and that all of the pending claims be considered.

The restriction under 35 U.S.C. 121 is not proper because the claims presented for alleged Inventions IB and IC are combination claims that require the particulars of the subcombination of alleged invention IA to show novelty and unobviousness for patentability.

According to MPEP section 808.02, "Where, as disclosed in the application, the several inventions claimed are related, and such related inventions are not patentably distinct as claimed, restriction under 35 U.S.C. 121 is never proper (MPEP § 806.05)".

MPEP section 806.05(c) states (*emphasis added*):

To support a requirement for restriction between combination and subcombination inventions, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., there would be a serious search burden as evidenced by separate classification, status, or field of search. See MPEP § 808.02.

The inventions are distinct if it can be shown that a combination as claimed:

(A) *does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness)*, and

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(B) the subcombination can be shown to have utility either by itself or in another materially different combination.

When these factors cannot be shown, such inventions are not distinct.

The latest restrictions clearly fail to meet the requirements stated in MPEP sections 808.02 and 806.05(c) because the filter in alleged Invention IA is a subcombination of which the particulars are necessary to show novelty and unobviousness in the combination in alleged Inventions IB and IC.

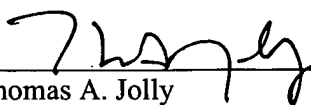
To illustrate such a situation, the guidelines in the MPEP with regard to 806.05(c) further state:

“Where a combination as claimed sets forth the details of the subcombination as separately claimed, there is no evidence that combination AB^{sp} is patentable without the details of B^{sp}. The inventions are not distinct and a requirement for restriction must not be made or maintained, even if the subcombination has separate utility. This situation can be diagrammed as combination AB^{sp} ("sp" is an abbreviation for "specific"), and subcombination B^{sp}. Thus the specific characteristics required by the subcombination claim B^{sp} are also required by the combination claim.”

Using this example in the present application, the filter of alleged Invention IA is the subcombination B^{sp} that is also required by the combination claims AB^{sp} of alleged Inventions IB and IC. Careful review of the above withdrawn claims is show that the filter of alleged Invention IA is recited in significant specificity in each of the combination claims AB^{sp} for alleged Inventions IB and IC subcombination. Thus, the restriction is not proper since the subcombination is essential to the combination.

Respectfully submitted,

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